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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/084,722

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Frederic Gaviot

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

HOSSAIN, FARZANA E

ART UNIT

PAPER NUMBER

2424

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/084,722	Applicant(s) GAVIOT ET AL.	
	Examiner FARZANA E. HOSSAIN	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/3/07 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to communications filed 09/26/2008. Claims 1-3 and 6-8 are amended. Claims 4-5 are original.

Response to Arguments

2. Applicant's arguments filed 01/09/2008 have been fully considered but they are not persuasive.

Regarding Claims 1-4 and 6-8, the applicant argues that Eyer does not teach the limitation of the claims including "generating an information signal consisting essentially of control information and an input program comprising at least one particular event (Pages 5 and 6). The applicant argues Eyer does not disclose a nonpaying user having access to additional access points (Page 6). The applicant argues that Eyer presumes only two conditions paying and non paying but the invention allows a plurality of various subscriptions (Page 8).

In response to the argument, the phrase "consisting essentially of" does not overcome the Eyer reference. The information system does consisting essentially of control information and an input program with at least one particular event. Eyer discloses an information signal with control stream and parallel input programs with particular events (Figure 10) and sending the input program comprising control stream

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or control data and a particular event and the control stream can be encrypted to all subscribers including paying and non paying subscribers (Column 2, lines 11-35, Column 4, lines 11-34). Eyer discloses the same information signal is transmitted to all subscribers and paying subscribers have access to the pay control stream which allows for users to skip or fast forward through all commercials to allow the user selectively output a program with or without a particular event or commercial (Column 4, lines 14-16, Column 6, lines 58-61, Column 17, lines 13-21). Therefore, Eyer discloses operating on the input program to selectively provide an output program comprising or not comprising a particular event according to the subscription (Column 16, lines 36-60).

The word “various” in its broadest reasonable interpretation are defined as different kinds or greater than one. The word “various” does not have a number established to it other than more than one in its definition. Eyer’s invention does not presume that a paying customer does not watch commercials. Also, Eyer does not teach away from an invention which may require paying customers to watch some commercials or allowing customers that do not pay to fast forward commercials. Eyer disclose a no-pay version which allows a user to skip the current commercial (Column 18, lines 49-54). Eyer discloses four class services or subscriptions which allows the customer to manage different tiers of service for commercial skipping (Table 1, Columns 18-19, Column 19, lines 10-45, Column 20, lines 18-26).

The limitations of the applicant’s invention is can be broadly interpreted. The applicant in order to overcome the Eyer reference needs to more clearly disclose a

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limitation with a single input program and relate the various subscriptions to the single input program.

The arguments for all remaining limitations have been addressed in previous office actions. The rejection is maintained as Eyer meets these limitations. See rejections.

The rejections for all dependent claims are maintained.

3. Regarding Claim 5, the applicant argues that Eyer does not render Claim 5 obvious (Page 10).

In response to the argument, see response to arguments of Claim 1. Rejection maintained.

Priority

4. Receipt is acknowledged of the prior filed foreign application. Applicant's specification should acknowledge the foreign application.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claims 1-6 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (See *In Re Bilski*, Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Claim 1 recites a method of subscription to a service in respect of a processing of an input program. However, the claim limitations are not tied to a machine or apparatus as required by *In Re Bilski*.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Eyer et al (US 6,588,015 and hereafter referred to as "Eyer").

Regarding Claims 1, 7, and 8, Eyer teaches a method of subscription to a service in respect of a processing of an input program comprising at least one particular event such as commercials or advertisement, songs, tracks, scheduled programming, i.e., TV shows), the method comprises the steps, implemented by a service provider:

generating an information signal consisting essentially of control information and an input program comprising at least one particular event (Column 2, lines 12-35, Column 4, lines 22-35, Column 15, lines 58-65, Column 16, lines 4-12) configurable by a provider of the information signal (Figure 1);

offering various subscriptions (service classes - Table 1, Columns 18-19) to a user who is to make a choice of subscription (Column 16, lines 23-60, Column 19, lines 11-45) and who is furnished with a device or program receiver for radio or TV (Figure 2, 200) comprising means for selecting of the particular event or the user selects the particular program selection they want from the track, programming stream, commercial (Column 4, lines 11-20; Column 7, lines 1-5, 16-18, 50) which can be configured on the basis of the chosen subscription (Figure 10; Column 15, lines 59-65, Column 16, lines 23-60) and

the means for selecting operating on the input program comprising at least one particular event to selectively provide an output program comprising or not comprising the particular event according to the chosen subscription in dependence on the control information or a person with subscription to a premium service can control what content

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is output and what content is not output or with the correct subscription commercials can be selected to play or not play by the user automatically based on the control data (Column 2, lines 12-35, Column 4, lines 22-35, Column 16, lines 4-12, 37-45; service class 1, Table 1, Column 18, line 54- Column 19, line 22) and operating on the input program having at least one particular event in order to store on a medium an output program comprising or not comprising the particular event based on the subscription and dependent control information (Column 18, lines 6-35; Column 16, lines 38-44; Column 16, lines 52-55; service class 2 - Column 19, lines 23-30);

validating (access-controlling and determining whether the user paid for the subscription service or not and what tier of service is enabled) the user's choice of subscription, which triggers a step of configuring the for selecting (Column 16, lines 29-34; Column 17, lines 13-20; Column 5, lines 61-67).

Regarding Claim 2, Eyer discloses all the limitations of Claim 1. Eyer discloses that the control information contains a table of events (control data comprises list of received programming and programming information), the means for selecting being suitable for selecting a particular event on the basis of an event status value in the table (Column 6, lines 1-7, lines 30-32, Column 2, lines 24-27, lines 32-35, Column 4, lines 25-26; Column 6, lines 50-61).

Regarding Claim 3, Eyer discloses all the limitations of Claim 1. Eyer discloses the device comprises means for accelerated reading of a recorded program; and means for deactivation for deactivating the accelerated reading means (fast-forwarding) of a

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recorded (buffered) program during the particular event in respect of a specified subscription (fast-forwarding of events such as commercials is disabled if the user does not have the proper subscription level based on the control data (Column 6, lines 56-61; Column 7, lines 50, 59-60; Column 16, lines 38-44; Column 16, lines 52-55; service class 2 - Column 19, lines 23-30).

Regarding claim 4, Eyer discloses all the limitations of Claim 1. Eyer discloses the particular event contains at least one advertisement (Column 16, lines 52-55).

Regarding claim 6, Eyer discloses all the limitations of Claim 1. Eyer discloses the validating step is implemented by the service provider by sending the device a signal characteristic of the chosen subscription, the signal being suitable for configuring the means for selecting as a function of the chosen Subscription (the service provider sends access control data/information which enables the device/decoder to detect what access the user has to control the received programming presentation in accordance with the service tier subscribed; Column 17, lines 13-21; Column 6, lines 55-61; Column 5, lines 57-67).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eyer in view of Applicant's admission of fact.

Regarding claim 5, Eyer discloses all the limitations of Claim 1. Eyer discloses the choice of the subscription is made by selecting one subscription from among several subscriptions offered (table 1, Column 18, lines 49-co1. 19, line 55) and further teaches a graphical interface 262 - Figure 2 linked to the receiver/device 200; Column 7, lines 25-28) and filtering content according to user input preferences Column 19, line 63-co1.20, line 17). However, Eyer fails to specifically disclose "on a graphics interface".

Applicant's admission of fact provides evidence to include use of graphical interfaces to enable user's to select subscriptions offered and filter content is accordance with user preference. (As evidenced by Serena US 2006/0031415, Figure 6; 610, Figure 7; Page 4, paragraphs 0047-0048).

It would have been obvious to one of ordinary skill at the time of the applicant's invention to modify the system of Eyer to include on a graphics interfaces for the advantage of enabling request for a higher tier of service to be made the user easily and quickly which increases the user's satisfaction of the product which will also generate increased revenue for the service providers.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FARZANA E. HOSSAIN whose telephone number is

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(571)272-5943. The examiner can normally be reached on Monday to Friday 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art
Unit 2424

FEH
November 4, 2008